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09/965,605	09/27/2001	Edgar Pau	3251/FBR	4654

7590 06/12/2003  
Rosenman & Colin LLP  
575 Madison Avenue  
New York, NY 10022-2585

EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/965,605

Applicant(s)

PAU ET AL.

Examiner

Robert Mosser

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 April 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

2. The corrected or substitute drawings were received on April 23<sup>th</sup> of 2002. These drawings are acceptable.

### ***Claim Objections***

3. Claim 10 is objected to because of the following informalities: "define" should be "defines". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Regarding claims 1, 14, and 17. The use of the word "typically" in claim 1 fails to distinctly define what is included in the meets and bounds of claimed invention.
6. Regarding claims 2-13, 15-16, and 18 are rejected for the incorporation of the above through their dependences.
7. The following limitations lack sufficient antecedent basis for this limitation in the claim.

Claims 6 and 7 recites the limitation "the game feature" in lines 23 and 25.

Claim 6 recites the limitation "the base game" in line 24.

Claim 6 recites the limitation "the occurrence of a special event" in line 24.

Claim 10 recites the limitation "the faces of a three dimensional object " in line 35.

Claim 18 recites the limitation "the three dimensional object " in lines 12-13.

Art Unit: 3714

8. Regarding claim 8 the reference of "a group including" represents an improper or open-ended Markush group. This replacement of "a group consisting of" is suggested.

9. Regarding claims 11 and 18. The reference "the three dimensional object" fails to distinctly specify which one of the group of "three dimensional objects" in the respective parent claims 10 and 17 to which it refer.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-4, 6-8, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Halloran (US Pat 6,450,883).

11. Regarding claim 1. O'Halloran teaches a gaming machine with display means (Element 20) and control means (Element 32) being disposed to play an underlying game (See Figure 2) wherein on the occurrence of a predefined event or triggering event (See Col 1:49) the player is enters a second game in which a common game type with two or more game choices are provided (See Col 1:50-51 & Col 2:12-24).

O'halloran further discloses the second game in which the player selects a card from a row of cards and where further the chance of the player selecting a card that would yield a winning out come is inversely proportional to the number of card per the row selected thus indicating a random assignment of the winning card as so claimed (See Col 2:16-24 & Figures 4 and 5)

12. Regarding Claims 2-4. O'Halloran teaches one winning outcome or the Joker card being presented per row or prize set and at least one non-winning outcome being presented per row or prize set (See Figure 5). This corresponds to one or more prize outcomes, which are identical in the same prize set or in a different prize set (See the middle and bottom rows of cards in figure 5) where in the identical prize outcomes are the non-winning outcomes represented via the non-Joker type playing cards.

13. Regarding claims 6-8 and in addition to the above stated. O'Halloran teaches the use of a combination of symbols appearing on the win lines of a spinning reel game of chance for the purposes of triggering a game feature (See Col 3:15-21). This corresponds to the occurrence of a special combination in claim 6 as presented, the triggering of a game feature at random in claim 7 as presented where in the random triggering is due to the random alignment of the trigger event or winning combination on a reel game, and a spinning reel game as presented in claim 8 (See Figure 2).

14. Regarding claim 12 and in addition to the above stated. O'Halloran teaches the presentation of each prize set distinctly as each prize set as so claimed is presented herein as a row of cards (See Figures 4 and 5).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 5, 9, 10, and 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573).

16. Regarding claim 5 and in addition to the above stated. O'Halloran teaches the presentation of player selectable prize sets through the use of successively increasing hands of cards but is silent on the use of a fixed set size or the use of a spinning wheel to define the prize outcome. Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that contain a fixed set size and spin randomly before stopping on a segment that defines a prize won (See Figures 4 & 6).

17. It would have been obvious to one of ordinary skill in the art at the time of invention to fix the set size of O'Halloran, in light of the teachings of Baerlocher et al, in order to give the perception of equal risk between multiple prize sets or alternatively

Art Unit: 3714

give the perception of a greater amount of total prize possibilities and to use a spinning wheel in order to extend the period of player anticipation through giving the impression that they are watching the determination of the game result in a similar fashion to the spinning of the reels of a traditional slot machine.

18. Regarding claims 9, 10, and 14-17 and in addition to the above stated.

O'Halloran teaches the presentation of player selectable prize sets that includes:

winning and non-winning outcomes and identical prize outcomes located between sets and located with in the same prize set but is silent on the use of use of a spinning wheel to define the prize outcome. Baerlocher et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates multiple spinning wheels or simulations thereof that spin randomly before stopping on a segment that defines a prize outcome won by the player (See Figure 6).

19. It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the use of a three dimension object or a simulation thereof in the machine disclosed by O'Halloran, in light of the teachings of Baerlocher et al, in order to increase the players enjoyment of the game both through the increased visual stimulus and to extend the period of player anticipation through giving the impression that they are watching the determination of the game result in a similar fashion to the spinning of the reels of a traditional slot machine.



20. Claims 10, 11, and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of DeMar et al (US Pat 6,315,660).

21.

22. Regarding claims 10 and 11 and in addition to the above stated. O'Halloran teaches the presentation of simulated playing cards but is silent on replacing this three dimensional object with dice. DeMar et al discloses a bonus game for a spinning reel game of chance containing a bonus round wherein a random role of dice (Element 64) determine the distance traveled on the board and the prize outcome (See Figures 1,6,8 and 13).

23. It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the use of dice as the three dimensional object in game representation in the game of O'Halloran, in light of the teachings of DeMar et al, in order to extend the period of player anticipation through giving the impression that they are watching the determination of the game result in a similar fashion to the spinning of the reels of a traditional slot machine.

24. Regarding claim 13 and in addition to the above stated. O'Halloran teaches the presentation of player selectable prize sets through the use of successively increasing hands of cards but is silent on the use of representations of board games or a random component after the selection. DeMar et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates a board game feature

(Element 62) wherein a random role of dice (Element 64) determine the distance traveled on the board and the prize outcome (See Figures 1,6,8 and 13).

25. It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the use of a dice and a board game representation in the game of O'Halloran, in light of the teachings of DeMar et al, in order to increase the visual stimulus for the player and further precipitate continued enjoyment in game through giving the impression that they are watching the determination of the game result in a similar fashion to the spinning of the reels of a traditional slot machine.

26. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over O'Halloran (US Pat 6,450,883) in view of Baerlocher et al (US Pat 5,788,573) in further view of DeMar et al (US Pat 6,315,660).

27. The combination as taught by O'Halloran/Baerlocher et al taught above is silent regarding the use of dice as the three dimensional object as so claimed. DeMar et al discloses a bonus game for a spinning reel game of chance containing a bonus round that incorporates a board game feature (Element 62) wherein a random role of dice (Element 64) determine the distance traveled on the board and the prize outcome (See Figures 1,6,8 and 13).

28. It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the use of dice as the three dimensional object in game representation in the game as taught by O'Halloran/Baerlocher, in light of the

Art Unit: 3714

teachings of DeMar et al, in order to extend the period of player anticipation through giving the impression that they are watching the determination of the game result in a similar fashion to the spinning of the reels of a traditional slot machine.

***Conclusion***

29. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kaminkow (US 6,511,375) discloses a gaming device having multiple selection group bonus round.

Mayereroff (US 6,231,442) discloses a video slot machine with multiple-choice second bonus.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (703)-305-4253. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

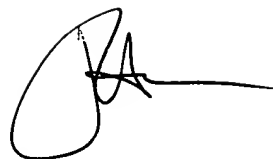
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Application/Control Number: 09/965,605  
Art Unit: 3714

Page 11

REM  
June 9, 2003

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a horizontal line and a small flourish.

**JESSICA HARRISON  
PRIMARY EXAMINER**